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10/051,316	01/18/2002	Alfred Thomas	2100/17	8018

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,316

Applicant(s)

THOMAS ET AL.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 28 August 2003.

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,3-47,49-80,82-103 and 112-115 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 112 and 113 is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☒ Claim(s) 13,23-35,56 and 89 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.

4) ☐ Interview Summary (PTO-413) Paper No(s) _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 114 is rejected under 35 U.S.C. 102(e) as being anticipated by ***Yoseloff et al*** (6,311,976).

Regarding claim 114, Yoseloff teaches a method of operating a gaming machine that comprises the steps of placing a wager; providing a first game of chance wherein said first game of chance is a slot machine having a reel display with a plurality of reels having first game indicia thereon, and wherein said step of providing said first game of chance includes a display of randomly selected first game indicia for each reel; providing a second game of chance, said second game of chance is operated only in conjunction with the first game of chance, wherein the second game of chance includes having a plurality of differing award indicia, a preset number of said award indicia being displayed in the course of the second game through a random selection, and said award is achieved through a predetermined association of said award indicia; and awarding any award achieved in said second game of chance (abstract; Fig. 1; Fig. 3; Fig. 7; Fig. 8).

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Claim 115 is rejected under 35 U.S.C. 102(e) as being anticipated by **Moody** (6,007,066).

Regarding claim 115, Moody teaches a method of operating a gaming machine that comprises the steps of providing a first game of chance which is a card game that concludes in a final outcome; providing a second game of chance which has the potential on every play thereof for achieving a prize award; placing a wager; operating the first game of chance; operating the second game of chance in conjunction with the first game of chance; and awarding any prize achieved in the second game of chance (abstract; Fig. 1; Fig. 16; col. 2, lines 42-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978).

Regarding claims 1, 3-9, 12, 15-21, 47, 49-52 and 58-77, Moody teaches a method of operating a gaming machine that comprises the steps of providing a first game of chance which concludes in a final outcome; providing a second game of chance which has the potential on every play thereof for achieving a prize award; placing a wager; operating the first game of chance; operating the second game of chance in conjunction with the first game of chance; and awarding any prize achieved in

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the second game of chance (abstract; Fig. 1; Fig. 16; col. 2, lines 42-65). Moody lacks the explicit disclosure of achieving only a prize award, which is non-monetary. In an analogous electronic slot gaming machine that includes slot games and simulated card games, Paulsen teaches the feature of prize awards that are only non-monetary (abstract; Fig. 1; col. 3, lines 27-30; col. 1, lines 33-39 and lines 50-57; col. 2, lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the non-monetary prize feature, as taught by Paulsen, as the prize award feature in the second game of Moody to provide more desirable gaming opportunities for players that are more attracted to games with non-monetary prizes and for game operators in jurisdictions that might restrict the prizes to non-monetary prizes, according to the gaming rules of those jurisdiction.

Regarding claims 10-11, 14, 53-55 and 57, Moody and Paulsen teach all the limitations of the claims as discussed above. The references lack the explicit disclosure of the prize indicia being in a like number to the cards in the hand. However, Moody teaches prizes associated with a combination of cards in the hands. It would have been obvious to a person of ordinary skill in the art at the time of the invention to associate a prize with each card in Moody to increase the players' anticipation of a winning outcome.

Regarding claims 36-43, 78-80, 82-88 and 90-103, Moody and Paulsen teach all the features of the claims as discussed above. Moody further teaches the feature of playing the second game in conjunction with the first game, irrespective of any result occurring in the first game (abstract).

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Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978), further in view of **Taylor** (6,569,013).

Regarding claim 22, Moody and Paulsen teach all the features of the claim as discussed above. While Moody and Paulsen teach a required wager that is at a first threshold value to operate the machine, the references lack the explicit disclosure of a wager greater than the first threshold value for the second game. In an analogous game of chance, Taylor teaches differing a wager greater than a first threshold for a second game outcome (col. 3, lines 12-17 and lines 55-60). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Taylor in Moody and Paulsen to increase the anticipation for the players to continue playing the second game; this would thereby increase participation and sales at the gaming machine.

Claims 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Moody** (6,007,066) in view of **Paulsen** (6,609,978), further in view of **Yamamoto** (5,135,224).

Regarding claims 44-46, Moody and Paulsen teach all the limitations of the claims as discussed above. Moody and Paulsen are silent regarding the printer to print a slip. This feature is taught by Yamamoto, as discussed in the initial office action (paper #2, 3/28/03), which is incorporated herein by reference. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature of Yamamoto in Moody and Paulsen to make it easier for the players to obtain and track their prizes.

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Allowable Subject Matter

Claims 112-113 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, particularly ***Moody*** (6,007,066), ***Taylor*** (6,569,013) and ***Paulsen*** (6,609,978), cited above, and ***Marnell II*** (5,393,057), ***Acres*** (5,836,817 and ***Yamamoto*** (5,135,224), cited in the initial office action, do not teach the features of ***said second game of chance is a game having a plurality of differing award indicia, wherein said award indicia are assigned to each card dealt from said deck of cards {claim 112} and wherein said second game of chance displays award indicia associated in a one to one correspondence with a card in said first game of chance {claim 113}.***

Claims 13, 23-35, 56 and 89 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The allowable subject matter is similar to the subject matter indicated as allowable above.

Examiner's Response to Applicant's Remarks

Applicant argues that Marnell II, Acres and Yamamoto do not teach the newly amended claim features. These arguments are now moot in light of the new grounds of rejection, recited above, due to the amended claim features. The examiner has

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addressed each claim feature in the above claim rejections, which include the newly cited references of Moody, Yoseloff, Taylor and Paulsen.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

USPTO Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


cdw


S. THOMAS HUGHES
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